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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/002,225

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Tony F. Rodriguez

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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

RAMAN, USHA

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

09/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/002,225	RODRIGUEZ, TONY F.	
	Examiner	Art Unit	
	USHA RAMAN	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-13-2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13th, 2008 has been entered.

Response to Arguments

2. Applicant's arguments filed on August 13th, 2008 have been fully considered but they are not persuasive.

Applicant argues that claim 21 is fully supported by applicant's specification by incorporation of reference of the '403 patent. The '403 patent however lacks the disclosure for the higher layer software interface operative to employ the decoded watermark data in connection with an application selected by the user. The '571 patent further lacks any disclosure decoding the 'bedoop' data that was "in band" within the content received. Accordingly the cited patents fail to establish that applicant was in possession of all the claimed features.

For the reasons stated above, the rejection is maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2623

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 17-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 17 recites the limitation “wherein by masking details of a particular hardware design by which the watermark decoder is implemented”. Applicant's specification (see page 3) discloses that with layered architecture, “higher layers are progressively more independent of the hardware – offering a hardware-independent for interacting with the system. By such approaches, software (and content) can more easily be used on a variety of platforms since the platform differences are masked by the layered architecture”. As such, “hardware-independent” is understood to be in reference to “platform-independent”. The disclosure is however silent about the software masking details of a particular *hardware design by which the watermark decoder* is implemented”.

Claim 21 recites the limitation of “a portable apparatus” that is “operative to make phone calls, send email and displayed received video data”. The ‘571 patent identifies the cell phone as the only instance of the portable apparatus operative to make phone calls, receiving email and

Art Unit: 2623

displaying received video data and therefore it lacks support any additional species under the “portable apparatus...operative to make phone calls, receiving email and displaying received video” genus.

Claim 21 additionally recites the limitation of “watermark decoder to decode a plural bit watermark data steganographically embedded “in band” within content data received using the wireless interface and processed by the apparatus”. Applicant cites the ‘403 patent incorporated by reference, for supporting the “plural bit watermark” being steganographically embedded in band within content data received. The ‘403 patent lacks the disclosure for the higher layer software interface operative to employ the decoded watermark data in connection with an application selected by the user. The ‘571 patent further lacks sufficient disclosure that supports the feature of bedoop data (i.e. plural bit watermark) being staganographically embedded in band within the content data received by the cell phone over wireless interface.

Clam 21 also recites the limitation of “software instructions.....causing the processor to establish a layered stack of protocols and a software interface”. The ‘571 patent lacks sufficient disclosure of the aforementioned feature by applicant’s own admission (see Remarks page 6). The instant specification also lacks the teaching of a “portable apparatus....”operative to make phone calls” with the aforementioned feature.

Therefore applicant has failed to sufficiently establish that applicant was in possession of the claimed invention at the time at the time the instant application was filed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (WO 02/07425) in view of Meyers et al. (US Pat. 7,188,186) as evidenced by "Sonique version .62 beta".

With regards to claim 17, Meyers discloses a consumer electronic apparatus for receiving content data with watermark data embedded "in band" within the content data. Examples of such consumer electronic apparatus include among other things, digital computer systems (see column 4, lines 24-28). Furthermore, Meyers discloses an application such as the well known "Sonique" mp3 player may render the content for output using output device, the rendered content including both the first content data (e.g. music) and auxiliary content obtained through the use of watermark data (see column 4, lines 55 -column 5, line 12). As such it is noted that computer systems comprise a hardware layer and comprises plural higher layers including an application layer at the higher level such as "Sonique" mp3 player. Examiner

Art Unit: 2623

further takes official notice that various hardware configurations for computer systems were well known in the art at the time of the invention. It is further noted that the Sonique mp3 software application can be various hardware configuration so long as the minimum system requirements are met, as evidenced by "Sonique version .62 beta" system requirements notes. Meyers additionally discloses the step of launching a web browser if a web browser is not already running and utilizing the browser to obtain the auxiliary content (see column 7, lines 63-column 8, line 7).

Myers is silent on the step of watermark decoding functionality provided by the watermark decoder can be invoked by the apparatus.

In a similar field, Chen discloses a consumer electronic apparatus comprising an input for receiving content data from the Internet (fig. 1A) and also including a memory and an output device (PC containing memory and monitor, see page 38, lines 1-2), the system further comprising a watermark decoder in the hardware layer to decode data steganographically embedded "in band" with the received content and to provide the decoded watermark data to a higher layer in the architecture (see pages 37, lines 21-33 and page 38, lines 1-9), processing circuitry responsive to instructions stored in the memory to execute a web browser in accordance with the watermark decoded by the watermark decoder. Accordingly Chen is evidence to one of ordinary skill in the art for decoding watermark at a hardware layer and subsequently providing the data to a higher layer (such as the presentation layer rendered in the system of Meyers).

Art Unit: 2623

All the claimed elements were known in the art and one ordinary skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

With regards to claims 18-20, the modified system is operative to decode plural bit watermark steganographically embedded within still image, audio or video content (see Meyers column 4, lines 21-24).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/

Supervisory Patent Examiner, Art Unit 2623